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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Yvonne Ng

Group Art Unit: 8838

Examiner: S. Lee

Serial No.: 09/538,767

Filed: March 30, 2000

For: SYSTEM AND METHOD FOR MANAGING A PLURALITY  
OF LOCAL LISTS OF A SINGLE USER

Attorney Docket No.: 1697 (USW 0562 PUS)

**APPEAL BRIEF**

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Sir:

This is an appeal brief in support of an appeal from the final rejection of claims 1-24 of the Final Office Action dated November 23, 2001.

**I. REAL PARTY IN INTEREST**

The real party in interest is Qwest Communications International Inc. US West, Inc. merged with Qwest Communications International Inc. The original assignment to US West, Inc. is recorded on reel/frame 010713/0637.

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## **II. RELATED APPEALS AND INTERFERENCES**

There are no appeals or interferences related to the present appeal.

## **III. STATUS OF CLAIMS**

Claims 1-24 are pending in this application. Claims 1-24 have been rejected and are the subject of this appeal.

## **IV. STATUS OF AMENDMENTS**

After final rejection, no amendments were filed.

## **V. SUMMARY OF THE INVENTION**

The present invention relates to a system and method for managing a plurality of local lists for a single user located at a plurality of remote appliances. Page 1, lines 4-5. Many products contain address books or similar lists that allow the user to keep names, telephone numbers, email addresses, bookmarks, and other personal contact information. These products do not all currently exist on the same network, nor are they all web enabled. A specific problem arises when a user that uses some or all of these products for various purposes, namely, the user has no easy way of synchronizing and accessing the lists. Page 1, lines 7-14. Although each product, alone, may be quite useful, it becomes difficult and cumbersome for the user to manage multiple lists of information on different products. Although some attempts have been made to provide portable devices that can store information for a user, the management of these devices still, at times, become difficult. Page 1, lines 15-25. The present invention provides a system and method for managing a plurality of local lists of a single user utilizing a compact user-carried smart card including a microprocessor and a

memory storing a master list configured for synchronizing with each local list. Page 2, lines 5-8.

With reference to Figure 1, claim 1 recites a system 10 for managing a plurality of local lists of a single user. The plurality of local lists is located at a plurality of remote appliances 22, 24, 26, 28, 30, 32. Each appliance holds a corresponding local list and includes a card reader. System 10 comprises a compact user-carried smart card 12 including a microprocessor 14 and a memory 16 storing a master list. The master list is configured for synchronizing with each local list. The microprocessor 14 is programmed to synchronize the master list with a local list on a remote appliance 22, 24, 26, 28, 30, 32 when the smart card 12 is engaged with the remote appliance card reader to allow the user to carry the smart card with the master list stored in the smart card memory 16 to various remote appliances 22, 24, 26, 28, 30, 32 and synchronize the master list with the various local lists of the appliances. With reference to Figure 3, advantageously, the smart card 62 acts as a token for holding the master list for various local lists kept on various devices such as computer 66, set top box 70, telephone 80, laptop 84, personal digital assistant 86, or even a cellular telephone 88. Page 6, line 9-page 7, line 4.

Claim 2 further recites an access type of remote appliance configured to display a list and including a card reader for example, a public phone 32 (Figure 1) may be configured to read the smart card and display the information stored therein, but not allow the user to modify that information at the public phone 32. Page 6, lines 6-8. The microprocessor 14 is further programmed to send the master list to the access type of remote appliance for display thereon when the smart card 12 is engaged with the remote appliance card reader of the access type remote appliance.

Claim 3 recites that the list includes a plurality of entries and at least one of the entries is an address. Claim 4 recites that the list includes a plurality of entries and at least one of the entries is a name. Claim 5 recites that the list includes a plurality of entries and at least

one of the entries is a telephone number. Claim 6 recites that the list includes a plurality of entries and at least one of the entries is an email address. Claim 7 recites that the list includes a plurality of entries and at least one of the entries is an electronic bookmark. Claim 8 recites that the memory also stores an electronic wallet. Claim 9 recites that the list includes a plurality of entries and at least one of the entries is a password. Claim 10 recites that the memory stores an encrypted smart card password to control access to the master list.

With continuing reference to Figure 1, claim 11 recites a system 10 for managing a plurality of local lists of a single user. The system comprises a plurality of remote appliances 22, 24, 26, 28, 30, 32 for use on different networks. Each appliance holds a corresponding local list of the plurality of local lists. Each appliance includes a card reader. For example, as shown in Figure 3, computer 66 is connected to network 68, set top box 70 is connected to network 74, and telephone 80 is connected to network 82. As recited in claim 11, the system further comprises a compact user-carried smart card 12 including a microprocessor 14 and a memory 16 storing a master list. The master list is configured for synchronizing with each local list. The microprocessor 14 is programmed to synchronize the master list with a local list on a remote appliance 22, 24, 26, 28, 30, 32 when smart card 12 is engaged with the remote appliance card reader. This allows the user to carry the smart card 12 with the master list stored in the smart card memory 14 to various remote appliances and synchronize the master list with the various local lists of the appliances.

Claim 12 further recites that the plurality of remote appliances 22, 24, 26, 28, 30, 32 includes at least one access type of remote appliance (for example, pay phone 32) configured to display a list and including a card reader. The microprocessor 14 is further programmed to send the master list to the access type remote appliance for display thereon when the smart card 12 is engaged with the remote appliance card reader of the at least one access type remote appliance.

Claim 13 recites that the plurality of remote appliances includes web enabled appliances and non-web enabled appliances. Claim 14 recites that the list includes a plurality of entries and at least one of the entries is an address. Claim 15 recites that the list includes a plurality of entries and at least one of the entries is a name. Claim 16 recites that the list includes a plurality of entries and at least one of the entries is a telephone number. Claim 17 recites that the list includes a plurality of entries and at least one of the entries is an email address. Claim 18 recites that the list includes a plurality of entries and at least one of the entries is an electronic bookmark. Claim 19 recites that the memory also stores an electronic wallet. Claim 20 recites that the list includes a plurality of entries and at least one of the entries is a password. Claim 21 recites that the memory stores an encrypted smart card password to control access to the master list.

With reference to Figure 2, claim 22 recites a method for managing a plurality of local lists of a single user. The method comprises storing a plurality of local lists on a plurality of corresponding remote appliances with each appliance including a card reader (block 42). A master list is stored on a compact user carried smart card including a microprocessor and a memory for storing the master list (block 44). The master list is configured for synchronizing with each local list. The microprocessor is programmed to synchronize the master list with a local list at a remote appliance when the smart card is engaged with the remote appliance card reader. Claim 23 further recites synchronizing the master list with at least one of the local lists (block 46). Claim 24 further recites that a plurality of remote appliances includes an access type of remote appliance (for example, pay phone 32) configured to display a list and including a card reader. The method recited in claim 24 further comprises sending the master list to the access type remote appliance for display thereon when the smart card is engaged with the remote appliance card reader of the access type remote appliance (block 48).

## **VI. ISSUES**

Whether claims 1, 3-6, 11, 14-17, and 22-23 are anticipated by Hohle (U.S. Patent No. 6,199,762).

Whether claims 2, 12, and 24 are unpatentable over Hohle.

Whether claims 7, 13, and 18 are unpatentable over Hohle in view of an article entitled "PubliCARD unveils SmartPassky™, the first smart card-enabled password management system for heavy Internet users" by PubliCard.

Whether claims 8 and 19 are unpatentable over Hohle in view of Teicher (U.S. Patent No. 5,744,787).

Whether claims 9 and 20 are unpatentable over Hohle in view of Taylor (U.S. Patent No. 5,578,808).

Whether claims 10 and 21 are unpatentable over Hohle in view of Chen (U.S. Patent No. 5,694,471).

## **VII. GROUPING OF CLAIMS**

Claims 1, 3-6, 11, 14-17, and 22-23 stand or fall together. Claims 2, 12, and 24 stand or fall together. Claims 7, 13, and 18 stand or fall together. Claims 8 and 19 stand or fall together. Claims 9 and 20 stand or fall together. Claims 10 and 21 stand or fall together. )

### **VIII. ARGUMENT**

Independent claim 1 recites a system for managing a plurality of local lists of a single user. The plurality of local lists is located in a plurality of remote appliances. Each appliance holds a corresponding local list and includes a card reader. The system comprises a compact user carried smart card including a microprocessor and a memory storing a master list. The master list is configured for synchronizing with each local list. Specifically, the microprocessor is programmed to synchronize the master list with a local list on a remote appliance when the smart card is engaged with the remote appliance card reader to allow the user to carry the smart card with the master list stored in the smart card memory to various remote appliances and synchronize the master list with the various local lists of the appliances.

The Examiner has rejected claim 1 as anticipated by Hohle. Independent claim 1 recites each appliance holding a corresponding local list and including a card reader. Independent claim 1 further recites that the microprocessor is programmed to synchronize the master list with a local list on a remote appliance when the smart card is engaged with the remote appliance card reader. That is, the compact user carried smart card may be carried by the user to various remote appliances and the master list may be synchronized with the various local lists of the appliances that include card readers. It is appreciated that the local lists are at the appliances, allowing the smart card to act as a token for the user, carrying the master list to each appliance for synchronization with the local list at that appliance when the smart card is received in a card reader. Hohle fails to describe or suggest remote appliances holding corresponding local lists with each remote appliance including a card reader and a microprocessor programed to synchronize the master list with a local list of a remote appliance when a smart card is engaged with the remote appliance card reader as recited by independent claim 1.

Hohle is directed to the more general smart card use which includes the use of a smart card for synchronizing data on the smart card with data in remote databases. That is,

card readers are located in various locations, however, the remote database is not located at each card reader but rather is located at a corporate partner of the smart card provider. In the more traditional smart card system of Hohle, data on the smart card is synchronized with data in the remote database such as a database at a corporate partner. In contrast, the present invention comprehends a new use for a smart card. For the new use, each appliance holds a corresponding local list and includes a card reader and a microprocessor on the smart card is programmed to synchronize the master list with a local list at a remote appliance when the smart card is engaged with the remote appliance card reader. Applicant is claiming a new use for a smart card and points out that independent claim 1 recites that the microprocessor is programmed to synchronize the master list with a local list on a remote appliance when the smart card is engaged with the remote appliance card reader. Hohle does not describe or suggest the claim invention of claim 1.

The Examiner states that Hohle anticipates claim 1 given its broadest reasonable interpretation. Applicant disagrees. Independent claim 1 specifically recites that the microprocessor is programmed to synchronize the master list with a local list on a remote appliance when the smart card is engaged with the remote appliance card reader. Hohle describes synchronizing data on the smart card with data in a remote data base such as a database at a corporate partner. In contrast, claim 1 recites that the microprocessor is programmed to synchronize the master list with a local list on a remote appliance when the smart card is engaged with the remote appliance card reader. Hohle does not describe or suggest a plurality of local lists located at a plurality of remote appliances and the claimed microprocessor being programmed to synchronize the master list with a local list in a remote appliance when the smart card is engaged with the remote appliance card reader.

Applicant's remaining independent claims, namely, independent claims 11 and 22, use similar language to recite that each appliance holds a corresponding local list and includes a card reader, and that the microprocessor is programmed to synchronize the master list with a local list on the remote appliance when the smart card is engaged with the remote



appliance card reader. For these reasons, independent claims 11 and 22 are also believed to be patentable. For example, claim 11 specifically recites a plurality of remote appliances for use on different networks wherein each appliance holds a corresponding local list of the plurality of local lists, and each appliance includes a card reader. Claim 11 further recites the compact user carried smart card with a microprocessor programmed to synchronize the master list with a local list at a remote appliance when the smart card is engaged with the remote appliance card reader. Specifically, claim 22 recites a method for managing a plurality of local lists of a single user. The method includes storing local lists on remote appliances and storing a master list at a compact user carried smart card. Claim 22 further recites a microprocessor programmed to synchronize the master list with a local list at a remote appliance when the smart card is engaged with the remote appliance card reader.

The remaining claims are dependent claims that are also believed to be patentable for reasons explained above. In addition, the remaining references relied upon by the Examiner fail to describe or suggest the elements of independent claims 1, 11 and 22 that are lacked by Hohle.

Applicant also maintains that the subject matter of claims 2, 12, and 24 is not obvious in view of Hohle. Specifically, Hohle operates in a far different way than the claimed invention, and applicant believes that the Examiner is misinterpreting the teachings of Hohle.

The Examiner disagrees with applicant and states that the card reader and display are essential equipment to read information stored on a smart card and to display status of the operating of the card reader. The Examiner further states that Hohle teaches the smart card reader and the PC system as an access point. Applicant points out that, for example, dependent claim 2 recites an access type of remote appliance wherein the microprocessor is further programmed to send the master list to the access type remote appliance for display thereon. That is, according to claim 2, there are access type remote appliances among other remote appliances and the smart card microprocessor is programmed

to interact in specific way with the access type remote appliance. Applicant maintains that Hohle does not describe or suggest the subject matter of dependent claims 2, 12, and 24.

### **IX. SUMMARY**

For reasons discussed above, it is respectfully submitted that claims 1-24 are patentable. The final rejection of claims 1-24 should be reversed.

The fee of \$320 as applicable under the provisions of 37 C.F.R. § 1.17(c) is enclosed. Please charge any additional fee or credit any overpayment in connection with this filing to our deposit account No. 02-3978.

Respectfully submitted,

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Enclosure - Appendix

**X. APPENDIX - CLAIMS ON APPEAL**

1. A system for managing a plurality of local lists of a single user, the plurality of local lists being located at a plurality of remote appliances wherein each appliance holds a corresponding local list and includes a card reader, the system comprising:

a compact user-carried smart card including a microprocessor and a memory storing a master list, the master list being configured for synchronizing with each local list, the microprocessor being programmed to synchronize the master list with a local list on a remote appliance when the smart card is engaged with the remote appliance card reader to allow the user to carry the smart card with the master list stored in the smart card memory to various remote appliances and synchronize the master list with the various local lists of the appliances.

2. The system of claim 1 wherein an access type of remote appliance is configured to display a list and includes a card reader, and wherein the microprocessor is further programmed to send the master list to the access type remote appliance for display thereon when the smart card is engaged with the remote appliance card reader of the access type remote appliance.

3. The system of claim 1 wherein the list includes a plurality of entries and at least one of the entries is an address.

4. The system of claim 1 wherein the list includes a plurality of entries and at least one of the entries is a name.

5. The system of claim 1 wherein the list includes a plurality of entries and at least one of the entries is a telephone number.

6. The system of claim 1 wherein the list includes a plurality of entries and at least one of the entries is an email address.

7. The system of claim 1 wherein the list includes a plurality of entries and at least one of the entries is an electronic bookmark.

8. The system of claim 1 wherein the memory also stores an electronic wallet.

9. The system of claim 1 wherein the list includes a plurality of entries and at least one of the entries is a password.

10. The system of claim 1 wherein the memory stores an encrypted smart card password to control access to the master list.

11. A system for managing a plurality of local lists of a single user, the system comprising:

a plurality of remote appliances for use on different networks wherein each appliance holds a corresponding local list of the plurality of local lists, and each appliance includes a card reader; and

a compact user-carried smart card including a microprocessor and a memory storing a master list, the master list being configured for synchronizing with each local list, the microprocessor being programmed to synchronize the master list with a local list on a remote appliance when the smart card is engaged with the remote appliance card reader to allow the user to carry the smart card with the master list stored in the smart card memory to various remote appliances and synchronize the master list with the various local lists of the appliances.

12. The system of claim 11 wherein the plurality of remote appliances includes at least one access type of remote appliance configured to display a list and including a card reader, and wherein the microprocessor is further programmed to send the master list

to the access type remote appliance for display thereon when the smart card is engaged with the remote appliance card reader of the at least one access type remote appliance.

13. The system of claim 11 wherein the plurality of remote appliances includes web-enabled appliances and non-web-enabled appliances.

14. The system of claim 11 wherein the list includes a plurality of entries and at least one of the entries is an address.

15. The system of claim 11 wherein the list includes a plurality of entries and at least one of the entries is a name.

16. The system of claim 11 wherein the list includes a plurality of entries and at least one of the entries is a telephone number.

17. The system of claim 11 wherein the list includes a plurality of entries and at least one of the entries is an email address.

18. The system of claim 11 wherein the list includes a plurality of entries and at least one of the entries is an electronic bookmark.

19. The system of claim 11 wherein the memory also stores an electronic wallet.

20. The system of claim 11 wherein the list includes a plurality of entries and at least one of the entries is a password.

21. The system of claim 11 wherein the memory stores an encrypted smart card password to control access to the master list.

22. A method for managing a plurality of local lists of a single user, the method comprising:

storing a plurality of local lists on a plurality of corresponding remote appliances, each appliance including a card reader; and

storing a master list on a compact user-carried smart card including a microprocessor and a memory for storing the master list, the master list being configured for synchronizing with each local list, the microprocessor being programmed to synchronize the master list with a local list on a remote appliance when the smart card is engaged with the remote appliance card reader.

23. The method of claim 22 further comprising:

synchronizing the master list with at least one of the local lists.

24. The method of claim 22 wherein the plurality of remote appliances includes an access type of remote appliance configured to display a list and including a card reader, and wherein the method further comprises:

sending the master list to the access type remote appliance for display thereon when the smart card is engaged with the remote appliance card reader of the access type remote appliance.